

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHILIP J. POTH

Appeal No. 1998-3128
Application No. 08/624,874

ON BRIEF

Before KRASS, BARRETT, and BARRY, Administrative Patent Judges.
BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the rejection of claims 1-10. We affirm-in-part.

BACKGROUND

The invention at issue in this appeal relates generally to numerical control (NC) and more particularly to computer numerical control (CNC). NC is the generic term applied to the automation of general purpose machine tools. CNC implements such automation through electronics and computers.

Building on advances of a now commercially available CNC machine controller, viz., the Thermwood 91000 SuperControl, the appellant's invention takes advantage of the controller's multi-processor, multi-tasking abilities to monitor and store status information about each controller in a multi-controller arrangement and to retrieve such information at a central remote site. More specifically, a number of CNC machine controllers are associated in the same plant or facility or in related facilities. Each CNC machine controller gathers and stores status information related to the state of operations being performed. A remotely located central computer separately addresses each controller to transfer the status information to a central location where the entire arrangement can be evaluated.

Claim 1, which is representative for our purposes, follows:

1. A system for selectively transferring information between a central computer and a plurality of remotely located computer-numerical-control (CNC) machine controllers, each having a multi-tasking capability comprising:

- a central computer;

a plurality of CNC machine controllers;

each of said controllers including means for storing a file of information to be transferred to said central computer;

a transfer means connected to said central computer and to each of said controllers for transferring information therebetween;

said central computer including means for selectively addressing each of said controllers and means for requesting an information transfer between said central computer and one of said controllers.

The references relied on in rejecting the claims follow:

Austin	4,281,379	July 28,
1981		
Kishi et al.	4,841,432	June 20,
1989.		

Claims 1-3 and 6-8 stand rejected under 35 U.S.C. § 103(a) as obvious over Austin. (Final Rejection at 2.) Claims 4, 5, 9, and 10 stand rejected under § 103(a) as obvious over Austin in view of Kishi. (Id.) Rather than repeat the arguments of the appellant or examiner in toto, we refer the reader to the briefs and answer for the respective details thereof.

OPINION

In deciding this appeal, we considered the subject matter on appeal and the rejection advanced by the examiner. Furthermore, we duly considered the arguments and evidence of the appellant and examiner. After considering the totality of the record, we are persuaded that the examiner did not err in rejecting claims 1-3 and 6-8 but did err in rejecting claims 4, 5, 9, and 10. Accordingly, we affirm-in-part.

We begin by noting the following principles from In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).... "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

We next find that the references represent the level of ordinary skill in the art. See In re GPAC Inc., 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995)(finding that the Board of Patent Appeals and Interference did not err in concluding that the level of ordinary skill was best determined by the references of record); In re Oelrich, 579 F.2d 86, 91, 198 USPQ 210, 214 (CCPA 1978) ("[T]he PTO usually must evaluate ... the level of ordinary skill solely on the cold words of the literature."). Of course, "[e]very patent application and reference relies to some extent upon knowledge of persons skilled in the art to complement that [which is] disclosed'" In re Bode, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977) (quoting In re Wiggins, 488 F.2d 538, 543, 179 USPQ 421, 424 (CCPA 1973)). Those persons "must be presumed to know something" about the art "apart from what the references disclose." In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). With the aforementioned principles and finding in mind,

we consider the obviousness of the following groups of claims:

- claims 1-3 and 6-8
- claims 4, 5, 9, and 10.

Claims 1-3 and 6-8

When the appeal brief was filed, 37 C.F.R. § 1.192(c)(7)
(1997) included the following provisions.

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and ... appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument ... why the claims are separately patentable.

In general, claims that are not argued separately stand or fall together. In re Kaslow, 707 F.2d 1366, 1376, 217 USPQ 1089, 1096 (Fed. Cir. 1983). When the patentability of dependent claims in particular is not argued separately, the claims stand or fall with the claims from which they depend. In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir.

1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

Here, the appellant concedes, "[c]laims 1-3 and 6-8 stand or fall together." (Appeal Br. at 7.) Therefore, the claims stand or fall together in a group. We select claim 1 to represent the group. With this representation in mind, we address the appellant's two arguments regarding claims 1-3 and 6-8.

First, he argues, "Austin teaches a totally different nomenclature from the present invention." (Appeal Br. at 11.) The reference belies the argument. More specifically, Figure 1 of Austin shows the claimed "central computer" as an intermediate computer or as an intermediate computer and a host computer. The Figure further shows the claimed "plurality of CNC machine controllers" as multiple machine control units (MCUs). In addition, Figure 1 depicts the claimed "transfer means" as a bus connecting the computers to the MCUs. The bus enables transferring information therebetween. Specifically, "the computer ... is used to

disseminate manufacturing data to, and to collect data from, many MCU's (see FIG. 1)." Col. 3, ll. 12-14. Because the MCUs transfer data to the intermediate computer and host, the units necessarily include the claimed "means for storing a file of information to be transferred to said central computer" and the computers must necessarily include the claimed "means for requesting an information transfer between said central computer and one of said controllers."

The use of addressing in computer and control systems to select between controllers and other devices attached to a bus was old and well known in the art. Because the reference teaches the plural MCUs on the bus, Austin's computers must necessarily include the claimed "means for selectively addressing each of said controllers"

Second, the appellant argues, "the MCU 9 lacks a multi-tasking feature, which feature is positively recited in claim 1." (Appeal Br. at 11.) "Generally, ... the preamble does not limit the claims." DeGeorge v. Bernier, 768 F.2d 1318,

1322 n.3, 226 USPQ 758, 761 n.3 (Fed. Cir. 1985). In particular, "[t]he preamble of a claim does not limit the scope of the claim when it merely states a purpose or intended use of the invention." In re Paulsen, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994) (citing DeGeorge, 768 F.2d at 1322 n.3, 226 USPQ at 761 n.3). "Where ... the effect of the words [in the preamble] is at best ambiguous ... a compelling reason must exist before the language can be given weight." Arshal v. United States, 621 F.2d 421, 430-31, 208 USPQ 397, 406-07 (Ct. Cl. 1980) (citing In re de Castelet, 562 F.2d 1236, 1244 n.6, 195 USPQ 439, 447 n.6 (CCPA 1977)).

Here, the expression "each having a multi-tasking capability" is found only in the preamble of representative claim 1. It merely states a purpose or intended use of the "system for selectively transferring information between a central computer and a plurality of remotely located computer-numerical-control (CNC) machine controllers" The body of the claim neither repeats nor references the multi-tasking capability. Because the language in the body of the claim

standing alone is clear and unambiguous, there is no compelling reason to give the expression weight.

For the foregoing reasons, we are persuaded that the teachings of Austin in combination with the prior art as a whole would have suggested the limitations of representative claim 1. Therefore, we affirm the rejection of claims 1-3 and 6-8 as obvious over Austin.

Our affirmances are based only on the arguments made in the briefs. Arguments not made therein are not before us, are not at issue, and are considered waived. Next, we address the obviousness of claims 4, 5, 9, and 10.

Claims 4, 5, 9, and 10

The appellant argues, "there is no disclosure or teaching related to the features associated with the predetermined time span." Claims 4 and 5 specify in pertinent part the following limitations: "storing status information for a predetermined current time span." Similarly, claims 9 and 10 specify in pertinent part the following limitations: "storing said status

information for a predetermined time span" Accordingly, claims 4, 5, 9, and 10 require storing status information for a predetermined time span.

The examiner fails to show a teaching or suggestion of the limitations in the prior art. The examiner does not allege, let alone show, that Austin teaches or would have suggested storing status information for a predetermined time span. He instead alleges that Kishi teaches "storing new status information in the new status file for a new time span (col. 6, lines 17-20)" (Examiner's Answer at 6.) To the contrary, the cited portion of the reference merely discloses that "the execution of a part program results in an optimum reconfiguration of the storage area, and there is no need to perform re-editing processing at the time of subsequent execution of the same part program." Col. 6, ll. 17-20.

Because Kishi merely teaches reconfiguring a storage area, we are not persuaded that teachings from the prior art anticipate or would have suggested the limitations of "storing status information for a predetermined current time span" or

"storing said status information for a predetermined time span
...." Therefore, we reverse the rejection of claims 4, 5, 9,
and 10 as obvious over Austin in view of Kishi.

CONCLUSION

In summary, the rejection of claims 1-3 and 6-8 under 35
U.S.C. § 103(a) as obvious over Austin is affirmed. The
rejection of claims 4, 5, 9, and 10 under § 103(a) as obvious
over Austin in view of Kishi, however, is reversed.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 C.F.R.
§ 1.136(a).

AFFIRMED-IN-PART

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	
)	
)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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LANCE LEONARD BARRY)	
Administrative Patent Judge)	

LLB/gjh

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APPEAL NO. 1998-3128 - JUDGE

APPLICATION NO. 08/624,874

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APJ KRASS

DECISION: **AIP**

Prepared By: APJ BARRY

DRAFT SUBMITTED: 10 Oct 02

FINAL TYPED:

Team 3:

I have typed almost all of this opinion.

Please provide insertions where needed including the mailing address.

Please check spelling, cites, and quotes.

Do NOT change matters of form or style.